

Appl. No. 09/633,180
Atty. Docket No. 8191
Amdt. dated 01/09/2004
Reply to Office Action of 09/10/2003
Customer No. 27752

REMARKS

Claims 1-11, 13, 14, 16 and 28 are pending in the present application. No additional claims fee is believed to be due.

Claims 30-50 have been cancelled, without prejudice, as being drawn to non-elected subject matter. The Applicants reserve the right to pursue the subject matter of said claims in one or more continuation and/or divisional applications.

Claim 1 has been amended to particularly point out and distinctly claim the subject matter that the Applicants regard as their invention. Support for the present amendment is found throughout the specification and claims, as originally filed, and specifically in Examples 68-94 and 100-107 of the present specification.

Claim 11 has been amended to correct a typographical mistake regarding the term "position". Support for this amendment is throughout the specification and claims as originally filed.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested

Rejection Under 35 USC 112, First Paragraph

The Office Action states that claim 1 is rejected under 35 USC 112, first paragraph, as purportedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Specifically, the Office Action states that phrases "mono- or polyvalent inorganic cation" and "mono- or polyvalent organic cation" included within the definition of R^2 lack description in the present specification. The Applicants respectfully direct the Examiner's attention to the "Amendments" section of the instant paper, in which the Applicants have amended claim 1 by removing the term "poly" from the phrase "mono- or polyvalent inorganic cation" included within the definition of R^2 . The Applicants have further removed the entire phrase "mono- or polyvalent organic cation." Support for the amended phrase "monovalent inorganic cation" is found within Examples 86-94 and 100-107 of the present specification, in which the Applicants clearly exemplify the addition of sodium salt during in the synthesis of the prostaglandin derivatives described therein, and subsequent allocation of Na (*i.e.*, a monovalent inorganic cation) in the R^2 position of the subject prostaglandin. It is respectfully submitted that the forgoing examples clearly establish that the

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Applicants were in position of compounds containing a monovalent inorganic cation. Further, the Applicants submit that the exemplification of Na in the R² position within Examples 86-94 and 100-107 provides ample guidance to a person of ordinary skill in the art with respect to the preparation of monovalent inorganic cation-containing prostaglandin compounds. Accordingly, the Applicants respectfully request reconsideration and withdrawal of the rejection to claim 1 under 35 USC 112, first paragraph.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 USC 112, first paragraph. Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in condition for allowance. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1-11, 13, 14, 16 and 28.

Respectfully submitted,

By 

Frank Taffy
Attorney for Applicant(s)
Registration No. 52,270
(513) 634-9315

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